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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,373	01/21/2000	Edward J. Koplar	55121-88011	5751
22807	7590	02/10/2005	EXAMINER	
GREENSFELDER HEMKER & GALE PC SUITE 2000 10 SOUTH BROADWAY ST LOUIS, MO 63102			SALTARELLI, DOMINIC D	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/489,373	KOPLAR ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dominic D Saltarelli	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 December 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 76-86,98,99,104,110,114,115,118,123 and 125-128 is/are pending in the application.
- 4a) Of the above claim(s) 123 and 125-128 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 76-86,98,99,104,110,114,115 and 118 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group 1: Claims 76-86, 98, 99, 104, 108, 110, 114, 115, and 118 are directed towards a hand held device which receives auxiliary data from a source for comparison to preprogrammed data provided by a sponsor, class 725 subclass 23.

Group 2: Claims 123 and 125-128 are directed towards a method for providing points to a user of a handheld device, class 725 subclass 23.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Randy Canis on January 14, 2005 a provisional election was made without traverse to prosecute the invention of group 1, claims 76-86, 98, 99, 104, 108, 110, 114, 115, and 118. Affirmation of this election must be made by applicant in replying to this Office action. Claims 123 and 125-128 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 76, 77, 98, 104, 108, 110, 114, and 118 rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee et al. (6,278,499) [Darbee] in view of Bullock et al. (5,070,404, of record) [Bullock] and Jernigan et al. (5,233,423) [Jernigan].

Regarding claims 76 and 98, Darbee discloses a hand-held device (fig. 1, hand held device 10) providing promotional opportunities (fig. 1, shown in display 14), the hand-held device comprising a receiver (fig. 2, receiver 34) disposed on the hand-held device for receiving data from a source (col. 6, lines 62-65) and a central processing unit (fig. 2, CPU 28). Darbee also discloses providing a display device for a viewer of an event (fig. 1, display 14).

Darbee fails to disclose circuitry having nonrewritable preprogrammed data embedded thereon by a sponsor prior to providing the hand-held device to a user, the receiver receives auxiliary data associated with the promotional opportunities of the sponsor while the viewer views the display device, and the CPU compares the auxiliary data against the nonrewritable embedded preprogrammed data and triggers promotional opportunities based on the comparison of the auxiliary data against the nonrewritable embedded preprogrammed data.

In an analogous art, Bullock teaches receiving auxiliary data (enabling or cue signal) associated with the promotional opportunities of a sponsor being displayed to a user of a television system, wherein received auxiliary data is compared against stored data to trigger promotional opportunities based on the comparison (col. 2, lines 34-50 and col. 6, lines 11-46), providing the benefit of

enabling promotional opportunities to users contemporaneously with advertisements (col. 6, lines 43-46).

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Darbee to include receiving auxiliary data associated with the promotional opportunities of a sponsor being displayed to a user of a television system which is then compared to locally stored data to trigger promotional opportunities based on the comparison, as taught by Bullock, for the benefit of enabling promotional opportunities to users contemporaneously with advertisements, making the advertisements more effective.

Darbee and Bullock fail to disclose the stored data is embodied in circuitry having nonrewritable preprogrammed data embedded thereon by a sponsor prior to providing the hand-held device to a user.

In an analogous art, Jernigan teaches providing promotional opportunities to users which are stored in circuitry, wherein the promotional opportunities are nonrewritable preprogrammed data embedded thereon by a sponsor prior to providing the device to a user (advertisements, provided by a sponsor, are stored on ROM, col. 2, lines 45-47), wherein ROM storage is not subject to tampering.

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Darbee and Bullock to include providing promotional opportunities to users which are stored in circuitry, wherein the promotional opportunities are nonrewritable preprogrammed data embedded

thereon by a sponsor prior to providing the device to a user, as taught by Jernigan, for the benefit of preventing unauthorized tampering of the promotional opportunities.

Regarding claims 77, 104, 108, 114, and 118, Darbee, Bullock, and Jernigan disclose the hand-hand device of claim 76, wherein the source is a display device and the receiver is a photodetector (Darbee, col. 6, lines 62-65).

Regarding claim 110, Darbee, Bullock, and Jernigan disclose the hand-held device of claim 76, and additionally disclose a plurality of lights in a sequenced array operatively associated with the central processing unit and disposed on the hand-held device, the sequenced array capable of notifying the user of one or more matches of the auxiliary data against the nonrewritable embedded preprogrammed data (Bullock teaches indicator lights associated with the processor light up on receipt of the auxiliary data which activates promotional data, col. 7, lines 47-54).

5. Claims 78-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee, Bullock, and Jernigan as applied to claim 76 above, and further in view of Borras et al. (5,301,353) [Borras].

Regarding claims 78-80, Darbee, Bullock, and Jernigan disclose the hand-held device of claim 76, but fail to disclose the source also includes a radio signal source and the receiver also includes a radio frequency receiver.

In an analogous art, Borras teaches a portable device which receives information both from optical sources and RF sources to enhance the usefulness of a portable information receiver (col. 2, lines 4-14).

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Darbee, Bullock, and Jernigan to include a radio signal source and a radio frequency receiver, as taught by Borras, for the benefit of enhancing the usefulness of the hand-held device to flexibly receive both optical and RF signals.

6. Claims 81, 82, 85, and 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky (5,594,493, of record) in view of Bullock.

Regarding claim 81, Nemirofsky discloses a hand-held device for providing promotional opportunities (col. 7, lines 25-49) comprising:

A receiver disposed on the hand-held device (fig. 7, lens 70, col. 7, lines 50-62) for successive reception of auxiliary data (benefit or value data) from a source at times scheduled by a sponsor during a single video program or program series (col. 11, lines 30-42);

A memory (fig. 5, RAM 30) operatively associated with the receiver and disposed on the hand-held device for storing the auxiliary data and a successive

reward data criteria (each successive benefit or value data received includes redemption criteria for the reward, including expiration dates and redemption locations, col. 11, lines 36-42), wherein the successive reward data criteria requires that user of the hand-held device capture the auxiliary data at the times scheduled by the sponsor during the single video program or program series (the user cannot receive the auxiliary data and corresponding reward data criteria at any time other than when scheduled by the sponsor, col. 11, lines 30-32);

A central processing unit (fig. 5, CPU 20) operatively associated with the memory and the receiver for determining whether the auxiliary data matches the successive reward data criteria (upon retrieval of a benefit for redemption, a comparison is made between the reward criteria and the auxiliary data to determine the availability of said reward and otherwise recall information regarding said reward from memory, such as serial numbers and code words to correct faulty point of purchase scans, col. 11 line 66 – col. 12 line 17).

Nemirofsky fails to disclose a plurality of lights in a sequenced array operatively associated with the central processing unit and disposed on the hand-held device, the sequenced array capable of notifying the user of one or more matches of the successive reward data criteria with the auxiliary data.

In an analogous art, Bullock teaches a plurality of lights in a sequenced array operatively associated with a central processing unit, the sequenced array capable of notifying the user of one or more matches of auxiliary data against preprogrammed data (indicator lights associated with the processor light up to

indicate active promotional data, col. 7, lines 47-54, wherein data is regarded as active upon a match between the coupon data and data which indicates that particular coupon is enabled, the 'cue signal', col. 2, lines 34-62), providing the benefit of a visual indication which informs the user of active and redeemable coupons in memory.

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Nemirofsky to include a plurality of lights in a sequenced array operatively associated with the central processing unit, the sequenced array capable of notifying the user of one or more matches of the successive reward data criteria with the auxiliary data, as taught by Bullock, for the benefit of providing a visual indication which informs a user of those coupons which are active and redeemable, for example, coupon data which has not yet expired would be recognized as such via a comparison of the coupon with its reward data criteria and would illuminate its corresponding light to designate availability.

Regarding claim 82, Nemirofsky and Bullock disclose the hand-held device of claim 81, wherein the source is a display device and the receiver is a photodetector (Nemirofsky, col. 11, lines 30-35).

Regarding claim 85, Nemirofsky and Bullock disclose the hand-held device of claim 81, wherein the plurality of lights are a plurality of LEDs (Bullock, col. 7, lines 25-34).

Regarding claim 115, Nemirofsky and Bullock disclose the hand-held device of claim 81, wherein the auxiliary data is modulated within a video signal in a substantially invisible way (col. 7, lines 25-40).

7. Claims 83 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky and Bullock as applied to claim 81 above, and further in view of Borras.

Regarding claims 83 and 84, Nemirofsky and Bullock disclose the hand-held device of claim 81, but fail to disclose the source also includes a radio signal source and the receiver also includes a radio frequency receiver.

In an analogous art, Borras teaches a portable device which receives information both from optical sources and RF sources to enhance the usefulness of a portable information receiver (col. 2, lines 4-14).

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Nemirofsky and Bullock to include a radio signal source and a radio frequency receiver, as taught by Borras, for the benefit of enhancing the usefulness of the hand-held device to flexibly receive both optical and RF signals.

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8. Claim 86 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky and Bullock as applied to claim 81 above, and further in view of Brooks et al. (5,483,276, of record) [Brooks].

Regarding claim 86, Nemirofsky and Bullock disclose the hand-held device of claim 81, but fail to disclose the lights are of different colors.

In an analogous art, Brooks teaches using a plurality of LEDs of different colors to provide color-coded messages as indicators (col. 8, lines 1-3).

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device of Nemirofsky and Bullock to include lights of different colors, as taught by Brooks, for the benefit of providing color coded indications to distinguish information (i.e. promotional opportunities).

9. Claim 99 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee, Bullock, and Jernigan as applied to claim 98 above, and further in view of Boggs et al. (4,789,371, of record) [Boggs].

Regarding claim 99, Darbee, Bullock, and Jernigan disclose the hand-held device of claim 98, but fail to disclose the hand-held device resembles a snap-shot camera.

In an analogous art, Boggs teaches a toy camera that resembles a snap-shot camera (fig. 1) which simulates a real camera (col. 2, lines 41-47) for the benefit of providing a familiar mechanism to simulate an image pickup device

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(col. 2, lines 60-68 and col. 4, lines 5-11) to provide entertainment (the device is a toy, col. 1, lines 10-30 and col. 2, lines 41-47).

It would have been obvious at the time to a person of ordinary skill in the art to modify the hand-held device disclosed by Darbee, Bullock, and Jernigan to resemble a snap-shot camera, as taught by Boggs, for the benefit of providing a familiar camera-like structure for using the hand-held device in an entertaining way.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bauminger et al. (6,681,393) who teaches a system for rewarding customers for interacting with commercial advertisements and August et al. (EP 0 713 335 A2) who teaches a hand-held device which captures data encoded onto a television signal.

11. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D Saltarelli whose telephone number is (703) 305-8660. The examiner can normally be reached on M-F 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli  
Patent Examiner  
Art Unit 2611

DS



HATRAN  
PRIMARY EXAMINER